



3510-16-P

DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Part 1

[Docket No. PTO-P-2019-0035]

Clarification of the Practice for Requiring Additional Information in Petitions Filed in Patent Applications and Patents Based on Unintentional Delay

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Clarification.

SUMMARY: The United States Patent and Trademark Office (USPTO) is clarifying its practice as to situations that will require additional information about whether a delay in seeking the revival of an abandoned application, acceptance of a delayed maintenance fee payment, or acceptance of a delayed priority or benefit claim was unintentional.

DATES: The clarification of practice set forth is applicable to any petition decided on or after [INSERT DATE OF PUBLICATION IN THE FEDERAL REGISTER].

FOR FURTHER INFORMATION CONTACT: Christina Tartera Donnell, Attorney Advisor, Office of Petitions, by telephone at 571-272-3211; or Douglas I. Wood, Attorney Advisor, Office of Petitions, by telephone at 571-272-3231; or by mail addressed to: Mail Stop Comments-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

SUPPLEMENTARY INFORMATION: Title II of the PLTIA amended the provisions of title 35, United States Code (U.S.C.), to implement the Patent Law Treaty (PLT). *See* Pub. L. No. 112-211, §§ 201-203, 126 Stat. 1527, 1533-37 (2012). Section 201(b) of the

PLTIA added a new 35 U.S.C. 27, which expressly provides that the director of the USPTO may establish procedures to revive an unintentionally abandoned application for patent or accept an unintentionally delayed issue fee payment, upon petition by the applicant for patent or patent owner. *See* Pub. L. No. 112-211, § 201(b)(1), 126 Stat. at 1534. Section 202(b)(1)(B) of the PLTIA amended 35 U.S.C. 41(c)(1) to provide that the director may accept the payment of any maintenance fee required by 35 U.S.C. 41(b) after the six-month grace period if the delay is shown to the satisfaction of the director to have been unintentional. *See* Sec. 202(b)(1)(B), Pub. L. No. 112-211, 126 Stat. at 1535-36. The 18-month publication provisions of the American Inventors Protection Act of 1999 (AIPA) amended 35 U.S.C. 119 and 120 to provide that a priority claim for a foreign or international application and a benefit claim to an earlier domestic provisional or nonprovisional application must be filed within the period required by the USPTO, but that the USPTO may establish procedures to accept an unintentionally delayed priority or benefit claim. *See* Pub. L. 106-113, 113 Stat. 1501, 1501A-563 through 1501A-564 (1999).

The USPTO revised the rules of practice to implement the 18-month publication provisions of section 4503 of the AIPA in September 2000. This included revising the rules of practice pertaining to foreign priority and domestic benefit claims (37 CFR 1.55 and 1.78) to set a time period within which such priority and benefit claims must be filed, and to provide for the acceptance of unintentionally delayed priority or benefit claims. *See* Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR 57023, 57024-25, 57030-31, 57053-55 (September 20, 2000). The USPTO revised the rules of practice for consistency with the PLT and title II of the PLTIA in October 2013.

This included revising the rules of practice pertaining to the revival of abandoned applications (37 CFR 1.137) and acceptance of delayed maintenance fee payments (37 CFR 1.378) to provide for the revival of abandoned applications and acceptance of delayed maintenance fee payments solely on the basis of “unintentional” delay, as well as revisions to the rules of practice pertaining to foreign priority and domestic benefit claims (37 CFR 1.55 and 1.78). *See* Changes to Implement the Patent Law Treaty, 78 FR 62368, 62377-78, 62380-83, 62399-400, 62402-07 (October 21, 2013).

The provisions for the revival of an abandoned application (37 CFR 1.137) require a petition including, *inter alia*, a statement that the entire delay in filing the required reply, from the due date of the reply until the filing of a grantable petition, was unintentional, but also provide that “[t]he Director may require additional information where there is a question whether the delay was unintentional” (37 CFR 1.137(b)(4)). The provisions for the acceptance of a delayed maintenance fee payment (37 CFR 1.378) similarly require a petition including, *inter alia*, a statement that the delay in payment of the maintenance fee was unintentional, but also provide that “[t]he Director may require additional information where there is a question whether the delay was unintentional” (37 CFR 1.378(b)(3)). The provisions for the acceptance of a delayed priority or benefit claim (37 CFR 1.55 and 1.78) likewise require a statement that the delay between the date the claim was due and the date the claim was filed was unintentional, but also provide that “[t]he Director may require additional information where there is a question whether the delay was unintentional” (37 CFR 1.55(e)(4), 1.78(c)(3) and (e)(3)).

The USPTO is clarifying its practice as to situations that will require additional information about whether a delay in seeking the revival of an abandoned application,

acceptance of a delayed maintenance fee payment, or acceptance of a delayed priority or benefit claim was unintentional. Specifically, the USPTO will require additional information in these cases, first, when a petition to revive an abandoned application is filed more than two years after the date the application became abandoned; second, when a petition to accept a delayed maintenance fee payment is filed more than two years after the date the patent expired for nonpayment; and third, when a petition to accept a delayed priority or benefit claim is filed more than two years after the date the priority or benefit claim was due. *See, e.g.,* Changes to Patent Practice and Procedure, 62 FR 53131, 53158-59, 53161 (October 10, 1997) (the length of the delay in filing a petition to revive may itself raise a question as to whether the delay was unintentional, and thus the USPTO may require additional information as to the cause of the delay when a petition to revive is not filed promptly). The reason for requiring additional information in cases where there has been an extended delay—a delay of more than two years from the date the application became abandoned, the patent expired, or a priority or benefit claim was due—until the filing of a petition, is to ensure that, in situations where there has been such an extended delay in filing the petition, the USPTO is provided with sufficient information of the facts and circumstances surrounding the entire delay to support a conclusion that the entire delay was “unintentional.”

Section 711.03(c) of the Manual of Patent Examining Procedure (MPEP) discusses the “unintentional” delay standard with respect to petitions to revive an abandoned application, but its discussion of the “unintentional” delay is generally applicable to any petition under the “unintentional” delay standard. The USPTO usually relies upon the applicant’s duty of candor and good faith and accepts the statement that

the entire delay was unintentional without requiring further information because the applicant or patentee is obligated under 37 CFR 11.18 to inquire into the underlying facts and circumstances when providing this statement to the USPTO. *See* MPEP § 711.03(c), subsection II.C. An extended period of delay (i.e., more than two years from the date the application became abandoned, the patent expired, or a priority or benefit claim was due) in filing a petition to revive an application, accept a delayed maintenance fee payment, or accept a delayed priority or benefit claim, however, raises a question as to whether the entire delay was unintentional. This may create uncertainty and unpredictability relating to patent rights in that there is a greater likelihood that the entire delay may not be “unintentional” within the meaning of 37 CFR 1.55, 1.78, 1.137, and 1.378, as compared to a petition that was filed within a shorter time period after the abandonment of the application, expiration of the patent, or due date for a priority or benefit claim. An applicant or patentee cannot meet the “unintentional delay” standard in 37 CFR 1.55(e), 1.78(c) and (e), 1.137(a), or 1.378(b) if the entire delay is not unintentional. *See* MPEP 711.03(c), subsections II.C. through F.

Furthermore, providing an inappropriate statement that the delay was “unintentional” may have an adverse effect when attempting to enforce the patent. *See In re Rembrandt Technologies LP Patent Litigation*, 899 F.3d 1254, 1272-73 (Fed. Cir. 2018) (patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the delay was unintentional). Revival of an application, reinstatement of a patent, or acceptance of a priority or benefit claim after an extended delay (i.e., more than two years since the date of abandonment, expiration of the patent, or due date of the priority claim) can also create uncertainty and unpredictability relating

to patent rights because the abandoned status of an application, or the expired status of a patent, or an absence of the priority or benefit claim, may be relied upon by other parties. Requiring additional information in these situations will improve the reliability and predictability of patent rights by ensuring that only applications and patents in which the entire delay was unintentional are revived or reinstated, and only priority or benefit claims for which the entire delay was unintentional are accepted.

Accordingly, any applicant filing a petition to revive an abandoned application under 37 CFR 1.137 more than two years after the date of abandonment, any patentee filing a petition to accept a delayed maintenance fee under 37 CFR 1.378 more than two years after the date of expiration for nonpayment of a maintenance fee, and any applicant or patent owner filing a petition to accept a delayed priority or benefit claim under 37 CFR 1.55(e) or 1.78(c) and (e) more than two years after the due date of the priority or benefit claim should expect to be required to provide an additional explanation of the circumstances surrounding the delay that establishes that the entire delay was unintentional. This requirement is in addition to the requirement to provide a statement that the entire delay was unintentional in 37 CFR 1.137(b)(4) and 1.378(b)(3), or 1.55(e)(4), or 1.78(c)(3) and (e)(3).

The USPTO may revisit the two-year time period established in this notice for requiring an additional explanation as to whether a delay is unintentional at a future point and may adjust the time period based on an evaluation of whether a two-year time period is appropriate for requesting additional information when determining whether a period of delay is unintentional. Nothing in this notice should be taken as an indication that the USPTO will only require additional information in consideration of a petition to revive

an abandoned application under 37 CFR 1.137 filed more than two years after the date the application became abandoned, a petition to accept a delayed maintenance fee payment in an expired patent under 37 CFR 1.378 filed more than two years after the date the patent expired, or a petition under 37 CFR 1.55(e) or 1.78(c) or (e) to accept a delayed priority or benefit claim filed more than two years after the due date of the priority or benefit claim. The USPTO may require additional information whenever there is a question as to whether the delay was unintentional.

Dated: February 18, 2020.

Andrei Iancu

Under Secretary of Commerce for Intellectual Property and

Director of the United States Patent and Trademark Office

[FR Doc. 2020-03715 Filed: 2/28/2020 8:45 am; Publication Date: 3/2/2020]